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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,324	04/14/2000	John Slaby	491.040US1	8731

21186 7590 03/17/2003

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
2142	10

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/550,324	SLABY ET AL.
	Examiner	Art Unit
	Melvin H Pollack	2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 14 April 2000.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 69-135 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 69-135 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 14 April 2000 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.

4) Interview Summary (PTO-413) Paper No(s). _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: *see attached office action*.

DETAILED ACTION

Priority

1. Applicant has been granted priority under 35USC 120 through the use of a PCT. However, a copy of the PCT and/or search report was not included in the application or any IDS submitted so far, and examiner was unable to obtain a copy. As the PCT may quote art that is relevant to the case, the examiner requests that the applicant submit an IDS with the PCT and any artwork mentioned in the PCT but not mentioned in any prior IDS.

Specification

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 69-135 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are all drawn to a "communication apparatus communicating with a remote configuration system over said network using initial configuration data." Yet, neither the claims nor the specification make it clear what this initial configuration data is. Nor is there any indication of whether the user, apparatus, network, or remote system is being configured. Is the remote system simply a repository for the information, and does that mean that the user gets to

develop the information? And what is the purpose of the remote server, if you can only access your own configuration data? The examiner recommends amendments to the claims to clarify these issues and to better place the claims in a certain embodiment. Amendments to the specification should be considered. The applicant must show that new matter was not added by pointing to the areas where such issues were touched up on.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 69-71, 75-78, 80-88, 91, 92 are rejected under 35 U.S.C. 102(e) as being anticipated by Farese et al. (4,996,685).

7. For claim 69, Farese teaches a method (see abstract) of remotely configuring communication apparatus (col. 1, lines 10-16) for communication over a network to access a service (Fig. 1), the method comprising the steps of:

- a. Connecting said communication apparatus (Fig. 1, #30) to said network (Fig. 1, #35);
- b. Said communication apparatus automatically communicating with a remote configuration system over said network (Fig. 1, #50) using initial configuration data (Fig. 4, #430);
- c. Said communication apparatus transmitting unique identification information to said configuration system (Fig. 4, #490);

- d. At said configuration system determining configuration data for said communication apparatus (Fig. 4, #490, and Fig. 5, #503-507);
- e. Transmitting said configuration data to said communication apparatus (Fig. 5, #503-507);
- f. Storing said configuration data received from said configuration data in storage means in said communication apparatus (Fig. 6, #620-630);
- g. Controlling subsequent communications by said communication apparatus over said network using the stored configuration data (Fig. 6);
- h. Transmitting subsequent configuration data to said communication apparatus automatically from said configuration system (Fig. 4-7);
- i. Storing said subsequent configuration data in said storage means (Fig. 7, #730-740); and
- j. Controlling subsequent communications by said communication apparatus over said network in accordance with the stored subsequent configuration data (Fig. 6 and 7).

8. As for claim 70, Farese also teaches a user (Fig. 1, #20) that initiates the process (Fig. 2, #213). Claim 71 is drawn to the use of a permanently open control channel associated with a plurality of data/voice channels (col. 1, lines 20-45).

9. For claims 75-78, Farese teaches that the network connects a LAN (Fig. 1, #60) to an ISDN line (Fig. 1, #25 and #35) that has a data channel and a plurality of bearer channels (col. 1, lines 27-46).

10. Claim 80 is drawn to a means implementation of many of the limitations in claim 70. If claim 70 is rejected, so is claim 80.

11. As for claims 81-83, Farese teaches that there is a dedicated data channel (D channel) for receiving configuration data (col. 8, lines 19-22).

12. Claims 84-86 are drawn to processing means that implement the limitations drawn in claims 72-74, respectively. If claims 72-74 are rejected, then claims 84-86 are also rejected for the reasons above.

13. As for claims 87 and 88, Farese teaches that the user I/O is a software program (Fig. 2A, #213).

14. As for claims 91 and 92, Farese teaches the encoding of the unique identification information (col. 21, lines 14-17) and the decoding of the configuration data (col. 21, lines 40-65). Examiner notes that encode and decode are not necessarily synonyms for encrypt and decrypt.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 69-78, 80-88, 90-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farese as applied to claims 69-71, 75-78, 80-88, 91, 92 above, and further in view of Ashton et al. (6,181,679).

17. For claims 69-71, 75-78, 80-88, that which is anticipated is obvious. Many of the limitations are also taught by Ashton (abstract).

18. For claims 72-74, Ashton teaches the monitoring of such a network in real time (Fig. 4) and the processing of the information (Fig 9) into a summary report (Fig. 10). This report is then sent to the network manager (col. 2, lines 20-34), which could be the provider or the user as currently drawn in the claims. At the time the invention was made, one of ordinary skill in the art would have recognized that the network in Farese requires such a monitoring system (col. 2, lines 14-20).

19. As for claim 90, Ashton teaches that the information is gathered and processed using machine independent instructions for output to said user (col. 16, lines 53-56). At the time the invention was made, one of ordinary skill in the art would have kept the system machine independent in order to support a wider variety of machines.

20. Claims 69-71, 75-89, 91-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farese as applied to claims 69-71, 75-78, 80-88, 91, 92 above, and further in view of Bhatia et al. (6,118,768).

21. For claims 69-71, 75-78, that which is anticipated is obvious. Many of the limitations are also taught by Bhatia (abstract).

22. As for claims 79 and 93, Bhatia teaches a connection of a POTS line (col. 15, lines 25-53). At the time the invention was made, one of ordinary skill in the art would have connected such a line to Farese in order to attach telephone equipment (Fig. 1, #20 and #25).

23. As for claim 89, Bhatia also teaches the use of a web server (Fig. 18 and 19). At the time the invention was made, one of ordinary skill in the art would have used a web server as a means of processing (col. 5, lines 1-10) as this was a standard method of I/O communication.

24. Claims 94-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farese, Ashton, and Bhatia.

25. Claims 94-104 are drawn to a communication apparatus that implements the method drawn in claims 69, 80-82, 84-86, 88, 90-92, respectively. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 69, 80-82, 84-86, 88, and 90-92 are rejected, then claims 94-104 are also rejected for the reasons above.

26. As for claims 105 –109, Farese teaches that the configuration data is selected based on the unique identification information, the previously gathered and stored user information, and the requested level of service (Fig. 4-7).

27. Claims 110-112 are drawn to a communication apparatus that implements the method drawn in claims 90-92, respectively. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 90-92 are rejected, then claims 110-112 are also rejected for the reasons above.

28. Claim 113 is drawn to a system implementation of claims 69 and 75. Claim 114 is drawn to a system implementation of claims 73 and 85. Claim 115 is drawn to a system implementation of claims 74 and 86. Claims 116-120 are drawn to a system implementation of claims 87-90, respectively. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 90-92 are rejected, then claims 110-112 are also rejected for the reasons above.

29. Claim 121-126 is yet another system implementation of claims 69, 85, 72, 88, 90, 105, respectively. The prior art teaches that a system implementation is functionally equivalent to

the underlying method. Therefore, if claims 69, 72, 85, 88, 90, and 105 are rejected, then claims 121-126 are also rejected for the reasons above.

30. Claims 127-129 are drawn to an independent method form of claims 72-74, respectively. If claims 72-74 are rejected, then claims 127-129 are also rejected for the reasons above.

31. Claim 130 is a system means claim for part of claim 69. Claim 131 is a word for word copy of claim 130, and must be cancelled. Claims 132, 133 and 135 are system means claim for other parts of claim 69. Claim 134 is a word for word copy of claim 133, and must be cancelled. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claim 69 is rejected, then claims 130-135 are also rejected for the reasons above.

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All of them read on many of the limitations in the independent claim and thus illustrate the broadness of the claims as currently drawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641. The examiner can normally be reached on 8-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark R Powell can be reached on (703) 305 - 9703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

MHP
March 10, 2003



**ROBERT B. HARRELL
PRIMARY EXAMINER**